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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,475	10/03/2003	David C. Collins	200310621-1	3351

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EXAMINER

PATTERSON, MARC A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/678,475

Applicant(s)

COLLINS ET AL.

Examiner

Marc A. Patterson

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 – 10, drawn to a solid freeform fabrication system, classified in class 428, subclass 34.1.
 - II. Claims 11 – 20, drawn to a method for solid freeform fabrication, classified in class 427, subclass 100.
2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a materially different process, such as a method which does not include the supporting of overhangs.
3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. W. Bradley Haymond on March 1, 2006, a provisional election was made with traverse to prosecute the invention of I, claims 1 – 10.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 11 – 20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

5. The disclosure is objected to because of the following informalities: The claimed aspect in Claim 6 of an open cavity that is partially defined by the build material and partially open to a surface of the three – dimensional object was not disclosed in the original specification.

Appropriate correction is required.

REPEATED REJECTIONS

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed aspect in Claim 6 of an open cavity that is partially defined by the build material and partially open to a surface of the three – dimensional object was not disclosed in the original specification.

NEW REJECTIONS

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 – 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ryan et al (WO 98/21626).

With regard to Claim 1, Ryan et al disclose a solid freeform fabrication system (page 4, lines 6 – 10) for producing a three dimensional object (having more than one layer; page 18, lines 15 – 25) comprising build material configured to be deposited in layers to form a three dimensional object (functionalizing material deposited so as to substantially fill a channel, therefore configured to be deposited in layers to form a three dimensional object; page 23, lines 16 – 22) and support material configured to be deposited adjacent to the build material for supporting the build material during formation of the three dimensional object (a layer of relief forming polymer, therefore configured to be deposited, providing retaining features and therefore providing the channel which is filled by the functionalizing material and also forming a feature that imparts a predetermined property of retention, which is a property other than support, within the three – dimensional object; the three dimensional object also therefore comprises embedded features; page 18, lines 15 – 25).

With regard to Claim 2, the claimed aspect of the build material disclosed by Ryan et al being deposited using an ink – jet printhead is directed to a method limitation and is therefore given little patentable weight.

With regard to Claim 3, the build material disclosed by Ryan et al is UV curable (page 19, lines 10 – 11).

With regard to Claim 4, the feature disclosed by Ryan et al is within a cavity defined by the build material (the feature is the property of retention, as stated above, and the retaining feature is filled with build material and therefore defined by the build material, as stated above).

With regard to Claim 5, the cavity disclosed by Ryan et al is a closed cavity that is completely defined by the build material (completely filled; page 22, line 29).

With regard to Claim 6, the cavity disclosed by Ryan et al is an open cavity that is partially defined by the build material and is partially open to a surface of the three dimensional object (partially filled; page 22, line 29; Figure 1e and g).

With regard to Claim 7, the feature disclosed by Ryan et al imparts color (the feature comprises a catalyst which is colored with a dye; page 15, lines 10 – 16 and page 16, lines 9 – 12).

With regard to Claim 8, the feature disclosed by Ryan et al imparts conductance (provides conductivity enhancement; page 16, line 28).

With regard to Claim 9, the build material disclosed by Ryan et al is transparent (non – UV curable, therefore transparent to UV radiation; page 18, lines 20 – 25).

With regard to Claim 10, the feature disclosed by Ryan et al comprises additional build material (the retaining feature disclosed by Ryan et al is partially or completely filled, as stated above, and therefore includes additional build material).

ANSWERS TO APPLICANT'S ARGUMENTS

10. Applicant's arguments regarding the Claims 1 – 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ryan et al (WO 98/21626), of record in the previous Action, have been carefully considered but have not been found to be persuasive for the reasons set forth below.

Applicant argues, on page 7, that the specification has been amended to overcome the objection of the previous Action.

However, as stated above, the claimed aspect in Claim 6 of an open cavity that is partially defined by the build material and partially open to a surface of the three – dimensional object was not disclosed in the original specification. The objection is therefore repeated above.

Applicant also argues, on page 8, that the specification has been amended to overcome the 35 U.S.C. 112, first paragraph rejection of the previous Action.

However, as stated above, the claimed aspect in Claim 6 of an open cavity that is partially defined by the build material and partially open to a surface of the three – dimensional object was not disclosed in the original specification. The amendment therefore constitutes new matter, as stated above.

Applicant also argues, on page 9, that the support material of Ryan et al does not impart color and conductivity enhancement.

However, it is not stated in the previous Action that color and conductivity enhancement are imparted by the support material.

Applicant also argues, on page 10, that a catalyst is not the support material of the claimed invention.

However, as stated above, a catalyst, as disclosed in Ryan et al, constitutes a support material.

Applicant also argues on page 10 that the support material disclosed by Ryan et al does not offer a feature in addition to support.

However, as stated above, the support material offers retention, in addition to support.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc A Patterson whose telephone number is 571-272-1497. The examiner can normally be reached on Mon - Fri 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marc Patterson 10/16/06

Marc A. Patterson, PhD.

Primary Examiner

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